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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/604,325

07/11/2003

Yu-Chuan Lin

9466-US-PA-R

1324

31561

7590

10/05/2005

JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE

7 FLOOR-1, NO. 100

ROOSEVELT ROAD, SECTION 2

TAIPEI, 100

TAIWAN

EXAMINER

SHIMIZU, MATSUICHIRO

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/604,325	<b>Applicant(s)</b> LIN ET AL.	
	<b>Examiner</b> Matsuichiro Shimizu	<b>Art Unit</b> 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-39 is/are allowed.
- 6) ☒ Claim(s) 1,2,7-9,14-16 and 21-27 is/are rejected.
- 7) ☒ Claim(s) 3-6,10-13 and 17-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> .           |

Continuation of Attachment(s) 6). Other: each copy of MPEP 706.03(k) and MPEP 502.03.

The Office acknowledges your acceptance regarding examiner's proposed amendment by incorporating allowed dependent claim 3 to claim 1 via e-mail received on 9/28/05. However, after further consideration by the Office, applicant is advised that should proposed claim 1 be found allowable, claim 28 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims are duplicated or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03 (k) (see attachment 1 to this Office Action). Also, proposed cancellation of claim 3 raises a 112 paragraph 2 question regarding claims 10 and 17 being dependent upon cancelled claim 3.

Furthermore, should you desire to communicate with the Office via Internet e-mail in the future, the Office requests the applicant to authorize the USPTO by providing the signed form per sample example in MPEP § 502.03 (see attachment 2 to this Office Action).

Therefore, this action is in response to applicant's amendment filed on 7/21/05.

### *Response to Amendment*

The examiner acknowledges currently amended claim 1 and new claims 28-39.

### *Response to Arguments*

Applicant's arguments filed on 7/21/05 have been fully considered and examiners response is provided as follows:

Regarding applicant's argument (lines 16-17, page 13), Baskin teaches for writing data and receiving data into/from the host via the connection port (col. 6, lines 37-44, bi-directional interface 12 and 50 associated with RS232 port);

Regarding applicant's argument (lines 9-11, page 14), Baskin teaches a controller (Fig. 7, controller in processor to generate control signal in the shift register or memory), receiving the key signal to produce a corresponding control signal.

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Regarding applicant's argument (lines 16-18, page 14), Baskin teaches a remote control signal emission module, transmitting a corresponding remote control signal (Figs. 1 and 7, data out signal 31 or keypad serial output is analogous to remote control signal) according to the control signal.

Therefore, rejection of claims 1-2, 7-9, 14-16 and 21-27 follows:

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 7-9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baskin et al. (5,307,055) in view of Miyashita (5,782,548).

Regarding claim 1, Baskin teaches a non-volatile memory device with wireline control function, comprising:

a main part, comprising:

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a connection port (col. 6, lines 37–44, bi-directional interface 21 and 50 associated with RS232 port) connected to microprocessor, electrically coupled to a host (Fig. 1, col. 4,, lines 26–31, computer associated with generator 10 and display 12), wherein the host provides a data (col. 4, lines 53–61, data associated image on the monitor 18) and a host power (col. 6, lines 37–44, RS232 port suggests power supply) to the non-volatile memory device (col. 4, lines 53–61, data associated image in the auxiliary display memory 15 and RAM memory in the Microprocessor 14) with wireline control function via an external bus connected to the connection port;

a memory system (Fig. 1, memory 15 and memory in Microprocessor 14), having a non-volatile memory (col. 3, lines 66–68 and col. 4, lines 22 and 55–58, col. 6, lines 37–44, bi-directional interface 21 and 50 associated with RS232 port, memory system associated with microprocessor 14, and an auxiliary display memory 15), for writing data and receiving data into/from the host via the connection port (col. 6, lines 37–44, bi-directional interface 12 and 50 associated with RS232 port); and

a remote control signal reception module (Fig. 1, microprocessor 14 suggests reception module via input receiving line 51); and

a remote control part comprising:

a function-key module (Fig. 7, col. 5, lines 50–68, data inputs producing key signal associated with key switches) producing a key signal while being pressed;

a controller, receiving the key signal to produce a corresponding control signal (Fig. 7, controller in processor to generate control signal in the shift register or memory); and

a remote control signal emission module, transmitting a corresponding remote control signal (Fig. 7, data out signal 31 or keypad serial output is analogous to remote control signal) according to the control signal;

wherein, after receiving the remote control signal, the remote control signal reception module produces a corresponding host control signal, and the host control signal is subsequently transmitted (Fig. 1, control signal is transmitted to host via line 21 and 50) back to the host via the connection port (Fig. 1, col. 6, lines 37–44, RS232 port 50) to control the host operations (Fig. 1, host including generator 10 and monitor 12 and 50).

But Baskin does not teach wireless control function; a first power storage unit, storing power for the remote control part operations; and emitting a corresponding remote control signal according to the control signal.

However, Miyashita teaches, in the art of remote presentation system, wireless control function (Fig. 2A–2B, wireless or optical transmission of control function via key commands), a first power storage unit (col. 12, lines 49–50, replaceable battery 410), storing power for the remote control part operations; and emitting a corresponding remote control signal according to the control signal (Fig. 2A, emitting via LED 36) for the purpose of providing larger area communication. Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to include wireless control function; a first power storage unit, storing power for the remote control part operations; and emitting a corresponding remote control signal according to the control signal in the device of Baskin because Baskin suggests wireline control function , and transmitting a corresponding remote control signal according to the control signal and Miyashita teaches wireless control

function; a first power storage unit, storing power for the remote control part operations; and emitting a corresponding remote control signal according to the control signal for the purpose of providing larger area communication.

Regarding claim 2, Baskin teaches the non-volatile memory device with wireless control function of claim 1, wherein the connection port (Fig. 1, col. 6, lines 37-44, RS232 port 50) comprising an interface connection device that is suitable for connecting to the RS232 interface.

Regarding claim 7, Baskin in view of Miyashita teaches the non-volatile memory device with wireless control function of claim 1, wherein the first power storage unit (Miyashita-col. 12, lines 49-50, replaceable battery 410) is electrically coupled to the connection port so as to receive the host power (Baskin-col. 6, lines 37-44, RS232 port suggests power supply coupling).

Regarding claim 8, Miyashita teaches the first power storage unit comprises a non-rechargeable battery (col. 12, lines 49-50, replaceable battery 410).

Regarding claim 9, Miyashita continues to teach, as claimed in claim 2, the first power storage unit comprises a non-rechargeable battery (col. 12, lines 49-50, replaceable battery 410).

Regarding claim 14, Miyashita teaches, as claimed in claim 7, the first power storage unit comprises a non-rechargeable battery (col. 12, lines 49-50, replaceable battery 410).

All subject matters in claim 31 are discussed above with regards to claims 1 and 4. Therefore rejection of the subject matters expressed in claim 31 are met by references and associated arguments applied to rejection of claims 1 and 4.



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Claims 15–16 and 21–22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baskin in view of Miyashita as applied to claim 1, 2, 7 above, and further in view of Moore et al. (5,584,554).

Regarding claims 15–16 and 21–22, Baskin in view of Miyashita teaches the non-volatile memory device with wireless control function of claim 1, wherein the main part receive power from the host (Baskin–col. 6, lines 37–44, RS232 port suggests power supply coupling). But Baskin in view of Miyashita is silent on the main part further comprises a second power storage unit, the second power storage unit is used to store a power and provide the power to the main part when the host power is lost.

However, Moore teaches, in the art of power supply system, a second power storage unit, the second power storage unit is used to store a power and provide the power to the main part (col. 3, lines 47–65, upon detecting power failure, initiation of start-up of a backup power supply takes place wherein backup power is a rechargeable battery (col. 9, lines 6–7)) when the host power is lost for the purpose of providing backup power supply. Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to include a second power storage unit, the second power storage unit is used to store a power and provide the power to the main part in the device of Baskin in view of Miyashita because Baskin in view of Miyashita suggests the main part receive power from the host and Moore teaches a second power storage unit, the second power storage unit is used to store a power and provide the power to the main part when the host power is lost for the purpose of providing backup power supply.

Claims 23–25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baskin in view of Miyashita as applied to claim 22 above, and further in view of Moore et al. (5,584,554).

Regarding claim 23, Miyashita continues to teach, as claimed in claim 22, the second power storage unit comprises a non-rechargeable battery (col. 12, lines 49–50, replaceable battery 410).

Regarding claim 24, Moore continues to teach, as claimed in claim 22, the second power storage unit comprises a rechargeable battery (col. 3, lines 47–65, upon detecting power failure, initiation of start-up of a backup power supply takes place wherein backup power is a rechargeable battery (col. 9, lines 6–7)).

Regarding claim 25, Baskin in view of Moore continues to teach, as claimed in claim 22, the second power storage unit (Moor–col. 3, lines 47–65, upon detecting power failure, initiation of start-up of a backup power supply takes place wherein backup power is a rechargeable battery (col. 9, lines 6–7)) is electrically coupled to the host power (Baskin–col. 6, lines 37–44, RS232 port suggests coupling associated with power supply).

Claims 26–27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baskin in view of Miyashita as applied to claim 25 above, and further in view of Moore et al. (5,584,554).

Regarding claim 26, Miyashita continues to teach, as claimed in claim 22, the second power storage unit comprises a non-rechargeable battery (col. 12, lines 49–50, replaceable battery 410).

Regarding claim 27, Moore continues to teach, as claimed in claim 22, the second power storage unit comprises a rechargeable battery (col. 3, lines 47–65,

upon detecting power failure, initiation of start-up of a backup power supply takes place wherein backup power is a rechargeable battery (col. 9, lines 6-7)).

*Allowable Subject Matter*

Claims 3-6, 10-13 and 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 3, the prior arts fail to teach or fairly suggest the first power storage unit further comprises a voltage feedback module, the voltage feedback module is used to detect whether the host power exists or not, so that the first power storage unit can provide the power to operate the remote control part when the host power is lost.

Claims 10 and 17 are directly/ or indirectly dependent on claim 3, therefore, the prior arts fail to teach or fairly suggest claims 10 and 17 for same reason that the prior arts fail to teach or fairly suggest claim 3.

Regarding claim 4, the prior arts fail to teach or fairly suggest the remote control part further comprises a charging module, the charging module is used to receive the host power and charge the first power storage unit with the host power.

Claims 5, 11-12 and 18-19 are directly/ or indirectly dependent on claim 4, therefore, the prior arts fail to teach or fairly suggest claims 5, 11-12 and 18-19 for same reason that the prior arts fail to teach or fairly suggest claim 4.

Regarding claim 6, the prior arts fail to teach or fairly suggest a voltage regulator, wherein the voltage regulator is used to adjust the host power to a voltage that is suitable for the non-volatile memory device with wireless control function.

Claims 13 and 20 are directly/ or indirectly dependent on claim 6, therefore, the

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prior arts fail to teach or fairly suggest claims 13 and 20 for same reason that the prior arts fail to teach or fairly suggest claim 6.

New claims 28-39 are allowable in view of new independent claims 28, 31 and 37 wherein previously allowed dependent claims 3-4 and 6 are incorporated.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matsuichiro Shimizu whose telephone number is 571-272-3066. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik, can be reached on 571-272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3068.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-8576).

Matsuichiro Shimizu  
October 3, 2005



MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600



The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

¶ 7.35 *Rejection, 35 U.S.C. 112, 2nd Paragraph Failure To Particularly Point Out And Distinctly Claim - Omnibus Claim*

Claim [ 1 ] rejected under 35 U.S.C. 112, second paragraph as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

**Examiner Note**

1.  
This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2.  
Use this paragraph to reject an "omnibus" type claim. No further explanation is necessary.
3.  
See MPEP § 1302.04(b) for cancellation of such a claim by examiner's amendment upon allowance.
4.  
An example of an omnibus claim is: "A device substantially as shown and described."

¶ 7.35.01 *Trademark or Trade Name as a Limitation in the Claim*

Claim [ 1 ] contains the trademark/trade name [ 2 ]. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe [ 3 ] and, accordingly, the identification/description is indefinite.

**Examiner Note**

1.  
In bracket 2, insert the trademark/trade name and where it is used in the claim.
2.  
In bracket 3, specify the material or product which is identified or described in the claim by the trademark/trade name.

**706.03(k) Duplicate Claims**

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being

a substantial duplicate of the allowed claim.

Form paragraphs 7.05.05 and 7.05.06 may be used where duplicate claims are present in an application.

¶ 7.05.05 *Duplicate Claims, Warning*

Applicant is advised that should claim [ 1 ] be found allowable, claim [ 2 ] will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

**Examiner Note**

1.

Use this form paragraph whenever two claims are found to be substantial duplicates, but they are not allowable. This will give the applicant an opportunity to correct the problem and avoid a later objection.

2.

If the claims are allowable, use form paragraph 7.05.06.

¶ 7.05.06 *Duplicate Claims, Objection*

Claim [ 1 ] objected under 37 CFR 1.75 as being a substantial duplicate of claim [ 2 ]. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

**Examiner Note**

If the duplicate claims are not allowable, use form paragraph 7.05.05.

See MPEP § 804 for double patenting rejections of inventions not patentable over each other.

**706.03(m) Nonelected Inventions**

See MPEP § 821 to § 821.03 for treatment of claims held to be drawn to nonelected inventions.

**706.03(o) New Matter**

*35 U.S.C. 132. Notice of rejection; reexamination.*

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

\*\*\*\*\*

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). See MPEP § 2163.06 - § 2163.07(b) for a discussion of the relationship of new matter to 35 U.S.C. 112, first paragraph. New matter includes not only the addition of wholly unsupported subject matter, but may also include adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See MPEP § 608.04 to § 608.04(c). See *In re*

copy of an international application pursuant to 35 U.S.C. 365) a copy of the certification, including a photocopy or facsimile transmission, will not be acceptable. The requirement for an original certification does not apply to certifications such as required under 37 CFR 1.8 since these certifications are not required by statute.

### **502.03 [R-2] Communications via the Internet**

The Office published a Patent Internet Usage Policy to

- (A) establish a policy for use of the Internet by the Patent Examining Corps and other organizations within the USPTO,
- (B) address use of the Internet to conduct interview-like communications and other forms of formal and informal communications,
- (C) publish guidelines for locating, retrieving, citing, and properly documenting scientific and technical information sources on the Internet,
- (D) inform the public how the USPTO intends to use the Internet, and
- (E) establish a flexible Internet policy framework which can be modified, enhanced, and corrected as the USPTO, the public, and customers learn to use, and subsequently integrate, new and emerging Internet technology into existing business infrastructures and everyday activities to improve the patent application, examining, and granting functions.

See *Internet Usage Policy*, 64 \*FR< 33056 (June 21, 1999). The Articles of the Patent Internet Usage Policy pertinent to communications via electronic mail are summarized below. See MPEP § 904.02(c) for information pertinent to Internet searching, and MPEP § 707.05(e) for information pertaining to the citation of electronic documents. See also MPEP § 713.04 for recordation of e-mail interviews.

#### **>I. < CONFIDENTIALITY OF PROPRIETARY INFORMATION (ARTICLE 4)**

If security and confidentiality cannot be attained for a specific use, transaction, or activity, then that specific use, transaction, or activity shall NOT be undertaken/conducted.

All use of the Internet by Patent Organization employees, contractors, and consultants shall be conducted in a manner that ensures compliance with confidentiality requirements in statutes, including 35 U.S.C. 122, and regulations. Where a written authorization is given by the applicant for the USPTO to communicate with the applicant via Internet e-mail, communications via Internet e-mail may be used.

Backup, archiving, and recovery of information sent or received via the Internet is the responsibility of individual users. The OCIO does not, and will not, as a normal practice, provide backup and recovery services for information produced, retrieved, stored, or transmitted to/from the Internet.

#### **>II. < COMMUNICATIONS VIA THE INTERNET AND AUTHORIZATION (ARTICLE 5)**

Communications via Internet e-mail are at the discretion of the applicant.

Without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the appropriate patent application.

The following is a sample authorization form which may be used by applicant:

"Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

A written authorization may be withdrawn by filing a signed paper clearly identifying the original authorization. The following is a sample form which may be used by applicant to

withdraw the authorization:

"The authorization given on \_\_\_\_\_, to the USPTO to communicate with me via the Internet is hereby withdrawn. I understand that the withdrawal is effective when approved rather than when received."

Where a written authorization is given by the applicant, communications via Internet e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used. In such case, a printed copy of the Internet e-mail communications MUST be given a paper number, entered into the Patent Application Locating and Monitoring System (PALM) and entered in the patent application file. A reply to an Office action may NOT be communicated by applicant to the USPTO via Internet e-mail. If such a reply is submitted by applicant via Internet e-mail, a paper copy will be placed in the appropriate patent application file with an indication that the reply is NOT ENTERED. >For Image File Wrapper (IFW) processing, see IFW Manual.<

USPTO employees are NOT permitted to initiate communications with applicants via Internet e-mail unless there is a written authorization of record in the patent application by the applicant.

All reissue applications are open to public inspection under 37 CFR 1.11(a) and all papers relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to public inspection under 37 CFR 1.11(d). USPTO employees are NOT permitted to initiate communications with applicant in a reissue application or a patentee of a reexamination proceeding via Internet e-mail unless written authorization is given by the applicant or patentee.

### **>III. < AUTHENTICATION OF SENDER BY A PATENT ORGANIZATION RECIPIENT (ARTICLE 6)**

The misrepresentation of a sender's identity (i.e., spoofing) is a known risk when using electronic communications. Therefore, Patent Organization users have an obligation to be aware of this risk and conduct their Internet activities in compliance with established procedures.

Internet e-mail must be initiated by a registered practitioner, or an applicant in a pro se application, and sufficient information must be provided to show representative capacity in compliance with 37 CFR 1.34. Examples of such information include the attorney registration number, attorney docket number, and patent application number.

### **>IV. < USE OF ELECTRONIC MAIL SERVICES (ARTICLE 7)**

Once e-mail correspondence has been received from the applicant, as set forth in Patent Internet Usage Policy Article 4, such correspondence must be responded to appropriately. The Patent Examiner may respond to an applicant's e-mail correspondence by telephone, fax, or other appropriate means.

### **>V. < INTERVIEWS (ARTICLE 8)**

Internet e-mail shall NOT be used to conduct an exchange of communications similar to those exchanged during telephone or personal interviews unless a written authorization has been given under Patent Internet Usage Policy Article 5 to use Internet e-mail. In such cases, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file, as required by the Federal Records Act, in the same manner as an Examiner Interview Summary Form is entered.

### **>VI. < POLICY GUIDANCE AND CLARIFICATIONS (ARTICLE 13)**

Within the Patent Organization, any questions regarding Internet usage policy should be directed to the user's immediate supervisor. Non-USPTO personnel should direct their